

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 12-33 were pending in the application, of which Claims 12 and 23 are independent. In the Final Office Action dated April 24, 2003, Claims 21 and 32 were rejected under 35 U.S.C. §112, Claims 12, 13, 23, and 24 were rejected under 35 U.S.C. §102(b), and Claims 12-14, 18-25, and 29-33 were rejected under 35 U.S.C. §103(a). Claims 15-17 and 26-28 were objected to, but were deemed allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Following this response, Claims 12-33 remain in this application. Applicants hereby address the Examiner's rejections in turn.

I. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

In the Final Office Action dated April 24, 2003, the Examiner rejected Claims 21 and 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Claims 21 and 32 have been amended, and Applicants respectfully submit that the amendment overcomes this rejection and adds no new matter.

II. Rejection of the Claims Under 35 U.S.C. § 102(b)

In the Final Office Action, the Examiner rejected Claims 12, 13, 23, and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,022,034 ("*Matsuda*").

Applicants respectfully traverse this rejection because *Matsuda* is non-analogous art.

There are two criteria in determining whether a reference is analogous: (1) whether the reference is in the field of the applicant's endeavor, regardless of the problem to be addressed, and (2) if not in the field of applicant's endeavor, then whether the reference still is reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. See *In re Clay*, 23 USPQ2d at 1061. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem that the invention attempts to solve. *Id.*

Applicants' invention is not in the same field of endeavor as *Matsuda*. The present invention, as recited by the claims, relates to protecting tubes for protecting cables, conduits, and the like. (See specification, page 1, lines 8-9.) In contrast, *Matsuda* is directed to slide fasteners. (See column 1, lines 6-7.) To the extent that the present invention, as recited by the claims, and *Matsuda* each concern Raschel-type warp knitting machines, Applicants submit that an inventor looking to protecting cables or conduits in the field of cables would not reasonably be motivated or expected to look to the field of slide fasteners to see how members comprising slide fasteners are utilized in that field. See, e.g., *In re Oetiker*, 24 USPQ2d 1443, 1146 (Fed. Cir. 1992) ("It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.").

Also, *Matsuda* is not reasonably pertinent to the particular problem with which the Applicants were concerned. The purpose of *Matsuda* is to provide reinforcements secured to a longitudinal edge of a stringer tape. (See column 1, lines 8-10.) Again, the present invention relates to protecting tubes for protecting cables, conduits, and the like. (See specification, page 1, lines 8-9.) Accordingly, because *Matsuda* is not analogous art, the Examiner may not rely upon this reference, and Applicants respectfully request withdrawal of the rejection of Claims 12, 13, 23, and 24 under 35 U.S.C. § 102(b)

III. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Final Office Action, the Examiner rejected Claims 12-14, 18-25, and 29-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,781,039 ("*Ribarev*") in view of *Matsuda*. Applicants respectfully traverse this rejection because *Matsuda* is non-analogous art and, alternatively, *Matsuda* and *Ribarev* may not be properly combined.

As shown above with respect to section II, *Matsuda* is not analogous art and Applicants respectfully submit that the Examiner may not rely upon this reference. However, even if *Matsuda* were analogous prior art as alleged by the Examiner, there is no teaching, suggestion, or motivation in either *Matsuda* or *Ribarev* to combine or modify the teachings of *Matsuda* or *Ribarev* to produce the claimed invention.

MPEP § 2143.01 states that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The protecting tube of *Ribarev* is made by a circular knitting machine, which has the drawback that its diameter is limited. The object of *Ribarev* is to "provide a circular knit product with a warp knit structure with higher strength, improved longitudinal elasticity and ohmic resistance, higher modulus of longitudinal bending, greater cohesion with a core, a possibility of color matching and decreased porosity, as well as a method of making same from a system of an arbitrary number of warp yarns, making a variety of different types and qualities of knitted structure possible." (See col. 1, line 67 – col. 2, line 7.) All of these objects can be obtained with a circular knitting machine, thus there is no motivation to modify *Ribarev* to use a Raschel knitting machine as disclosed in *Matsuda*. Moreover, *Ribarev* had no reason to use the Raschel knitting machine described by *Matsuda* to increase the diameter of the tube because it was not *Ribarev*'s object. It should also be noted that the Raschel knitting machine used in the application is also a flat knitting machine, not a circular knitting machine.

Accordingly, Applicants respectfully submit that there is no teaching in the cited prior art to combine the references as required by MPEP § 2143.01. Therefore, *Matsuda* and *Ribarev* cannot be properly combined to teach or suggest the invention as recited in Claims 12 and 23. Accordingly, independent Claims 12 and 23 patentably distinguish the present invention over the cited art, and Applicants respectfully request withdrawal of the rejection of Claims 12 and 23.

Dependent Claims 13-22 and 24-33 are also allowable at least for the reasons above regarding independent Claims 12 and 23, and by virtue of their respective

dependencies upon independent Claims 12 and 23. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 13-22 and 24-33.

IV. Conclusion

Applicants respectfully request that this Amendment After Final be entered by the Examiner, placing the claims in condition for allowance. Applicants respectfully submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants respectfully submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants respectfully submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

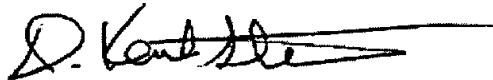
In view of the foregoing, Applicants respectfully submit that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only on the arguments in the Official Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the

Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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